

REMARKS

Applicant appreciates the attention of the Examiner to this application. The Office Action of January 7, 2005, has been reviewed with care in the preparation of this response. The amendments above are intended to further clarify Applicant's invention and do not include any new matter. The claims as amended are patentably distinguishable from prior art and are in condition for allowance. Claims 8, 9, 10, 17 and 18 are withdrawn without prejudice to facilitate prosecution. This amendment and the following remarks are believed to be fully responsive to this action.

Before turning to the a discussion of the claim rejections, as a preliminary matter, Applicant notes nonsubstantive amendments are made to correct minor typographical issues and to provide consistency. Additionally, Applicant made minor amendments to the Brief Description of the Drawings to further clarify and explain the drawings. No new matter has been added.

Applicant next addresses amendments made to the drawings. In FIGS. 1 and 2, Applicant amended the drawings to include dark bands. The original application supports this amendment. For example, both FIG. 3 and page 8, line 16 of the original application disclose dark bands. Applicant also deleted all references to item number 70. Item 70 in the original application is end closures. Also present in the original application are first and second end closures, 71 and 72 respectively, which more particularly describe the relevant parts. Applicant deleted item 70 in the interests of clarity. Similarly, all references to item 60 and item 40 have been deleted from the figures. As with the deletion of item 70, both item 60 dark-colored bands and item 40 marker ring in the original application have been removed for clarity. Finally, in FIG. 2, Applicant added a bubble between first and second marker rings. The original disclosure supports this amendment. For example, FIG. 3 and page 8, lines 11-13 of the originally filed application each disclose a bubble within the cavity positioned between marker rings 41 and 42. Applicant now turns to the merits of the claim rejections.

**A. Rejection Under 35 USC Section 102(b)**

Claims 1-3, 11-13, and 16 were rejected under 35 USC section 102(b) as being anticipated by U.S. Patent No. 4,542,592 (Hopkins). Applicant amended Claims 1 and 11. Applicant believes no substantive amendments to the remaining claims are required. In light of the above amendments and the following remarks, Applicant respectfully traverses the rejection of the claims and asks that they be withdrawn. These claims are not anticipated by the reference cited by rather are patentably distinguishable over the prior art.

Hopkins discloses a wheeled vehicle leveling device and method. Hopkins teaches nothing about enhancing the interface to increase the visibility of the bubble. The reference does not disclose a vial including first and second dark bands as in the claimed invention. Rather, Hopkins merely discloses a bubble level vial secured in the level housing so that “a level position is indicated by a bubble located between indicator marks.” Column 3, lines 58-61. Figure 7 of Hopkins discloses a vial with first and second ends; two indicator marks, one on either side of the bubble. Examiner stated that member 34—the vial housing—has first and second dark bands. However, nowhere in either the specification or in the claims is there any disclosure of first and second dark bands. Noticeably absent from the drawings is there any disclosure of dark bands of any sort.

Under these facts, Claims 1-3, 11-13 and 16 are not anticipated by Hopkins because Hopkins does not contain, and indeed does not even come close to containing, each and every element of the claimed invention as required by 35 USC 102. *See also Verdegaal Bros., Inc. v. Union Oil Co.*, 714 F.2d 628, 631 (Fed. Cir. 1987); *Jamesbury Corp. v. Litton Indus. Produs., Inc.*, 756 F.2d 1556, 1560 (Fed. Cir. 1985); 1.0 Donald S. Chisum, *Chisum on Patents* § 6 (2003). Furthermore, in view of the foregoing, Hopkins does not teach even the slightest hint of obviousness in the above claims. As such, Applicant respectfully requests allowance of Claims 1-3, 11-13 and 16.

**B. Rejections Under 35 USC Section 103**

Claims 4-6, 14 and 15 were rejected under 35 USC section 103(a) as being unpatentable over Hopkins. Claim 7 was rejected under 35 USC section 103(a) as being

unpatentable over Hopkins in view of U.S. Patent No. 2,362,872 (Weagle). However, as to all other remaining claims, whether amended or in original form, Applicant respectfully traverses the rejection of these claims and ask that they be withdrawn. These claims are not rendered obvious by the references cited, but rather, are patentably distinguishable over the prior art.

Obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). In addition, any such combination or modification of the prior art must teach or suggest each and every one of the claim limitations. MPEP § 2143. MPEP section 2141 identified four basic considerations which must be applied when making a section 103(a) rejection. They are as follows:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (c) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (d) Reasonable expectation of success is the standard with which obviousness is determined.

For the reasons stated below, these conditions are not satisfied in the present case. Applicant now turns to the particular points raised by the Examiner in the Office Action of January 7, 2005.

Applicant begins with those claims rejected as being unpatentable over Hopkins. Claims 6, 14 and 15 are directed to a vial for use in a level comprising first and second dark bands that enhance the visibility of the bubble in the vial. Applicant's invention provided a number of novel elements, but arguably most importantly, it provided enhanced readability for the user of the level. In addition to this element of novelty, Applicant also disclosed dark bands that are integrated with the body of the vial.

In contrast, Hopkins, taken as a whole, discloses a wheeled vehicle leveling device and method. Specifically, Hopkins discloses a bubble vial wherein indicator marks are positioned on

either side of the bubble. The indicator marks are not akin to the dark bands of the claimed invention, but rather are comparable to the marker rings. As discussed above, Hopkins does not disclose a dark-banded vial wherein the marker rings (“indicator mark” as it is termed in Hopkins) are separate and distinct from the first and second dark bands. Further, Hopkins does not disclose a vial with separate dark bands having the purpose of enhancing visibility of the bubble. In other words, the indicator marks in Hopkins are no different or unique than those found in any other level vial.

Even assuming, arguendo, that Hopkins discloses the first and second dark bands of the claimed invention, the Examiner correctly noted Hopkins does not disclose dark bands integrated with the body of the vial as in the claimed invention. Claims 4-6, 14 and 15 each disclose a vial with dark bands wherein the dark bands are integral with the body of the vial. However, Applicant disagrees with the Examiner that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the bands and/or markers in of [sic] Hopkins in *any* of the manners claimed for the purpose of simplifying the Hopkins device.” (Emphasis in original.)

In making a 35 USC section 103 rejection, it is incumbent upon the examiner to provide a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). The examiner must provide a reason why one of ordinary skill in the art would have been led to modify or combine prior art references to arrive at the claimed invention. Such reasons must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally possessed by one with ordinary skill in the art. *Uniroyal Inc. v. Rudkin Wiley Corp.*, 837 F.2d 1044, 1051 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Applicant is unable to find any specific factual basis in Examiner’s Summary to support the conclusion that it would have been obvious to one skilled in the art at the time the invention was made to integrate the “bands” of Hopkins. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

prior art suggested the desirability of the modification. See *In re Fritch*, 972 F.2d 1260, 1266 n.4 (Fed. Cir. 1992). Nothing in Hopkins suggests the desirability of integrating the bands to the body of the vial. Moreover, the Examiner has not met his burden to present a factual basis for this assertion.

Examiner's basis for rejection relies entirely on the case of *In re Larson*, 144 USPQ 347 (CCPA 1965). According to the Examiner, *In re Larson* held that "making something integral on an apparatus is obvious." Applicant can find no such holding and respectfully asserts this is not a complete statement of the law. The only statement in *In re Larson* that Applicant thinks the Examiner relied upon is one which indicates that:

Then, too, we are inclined to agree with the position of the solicitor that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.

In *In re Larson*, the structure of the prior art comprised several parts. Applicant asserts it is clear from this statement that *In re Larson* does not hold as a matter of law that reducing the number of parts on an apparatus is *per se* obvious.

Contrary to the Examiner's assertion, there "is no per se rule that making something in one piece that was formerly made in two or more pieces renders it obvious." *Mooney v. Brunswick Corp.*, 489 F. Supp. 544, 561 (E.D. Wis. 1980). There are circumstances under which it is perfectly acceptable to integrate parts and meet the requirements of patentability. See, e.g., *In re Miller*, 329 F. 2d 1015 (CCPA 1964). There is no bright line rule, but rather, the proper inquiry must focus on what "improvement results from the one piece construction and whether the improvement or construction itself was obvious from the prior art." *Mooney*, 489 F. Supp. at 561.

In the present case, the mere fact that one of ordinary skill in the art, once informed of the desirability of integrating the bands with the body of the vial as defined in Applicant's claims, could achieve this result though the application of routine skill in the art, provides no evidence that such modification would have been obvious to those of ordinary skill in the art at the time of

Applicant's invention, absent Examiner's reliance upon Applicant's disclosure. Such reliance is an impermissible basis for a 35 USC section 103 rejection. Moreover, such integration of the bands with the body of the vial served a useful purpose and required more than the application of mere mechanical skill. *See In re Murray*, 53 F.2d 541, 543 (CCPA 1931). By integrating the bands with the body of the vial, location problems related to the bands were eliminated. By way of example, this eliminated band insertion problems and other variables that were theretofore unaddressed in the art. Any combination of Hopkins and Weagle to meet the limitations of the claimed invention would be possible only with the benefit of the Applicant's disclosure. *See* MPEP § 2141. The undersigned believes the Examiner's legal conclusion of obviousness is therefore based on impermissible hindsight. As such, because Hopkins reveals no motivation for modifying the vial by incorporating the bands with the body of the vial, the referenced prior art does not render the integration obvious. Therefore, Applicant respectfully requests allowance of Claims 4-6, 14 and 15.

Finally, Claim 7 was rejected under 35 USC section 103(a) as being unpatentable over Hopkins in view of Weagle. For the reasons stated above, Applicant asserts the claimed invention is not obvious over Hopkins. Even assuming it is, Claim 7 is not obvious over Hopkins in view of Weagle for the following reasons.

Weagle discloses a spirit level comprising an elongated container closed at opposite ends. Column 5, lines 23-24. However, Weagle does not teach a level comprising a vial with first and second end closures wherein the end closures are dark. In the claimed invention, the first and second dark end closures contribute to the enhanced visibility and readability of the bubble in the vial. The dark end closures reflect the interface in the same way the dark bands reflect the interface and thereby further enhance the visibility of the bubble. Any such combination or modification of the prior art must teach or suggest each and every one of the claim limitations. MPEP § 2143. Because Hopkins in view of Weagle does not teach each and every one of the claim limitations, it would not have been obvious to one skilled in the art to have included end closures that are dark. As such, Applicant respectfully requests allowance of Claim 7 in view of the amendment and above remarks.

In re Patent Application of:  
Thomas P. Foran  
Serial No.: 10/826,854

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Conclusion

Applicant believes that the above-noted amendment and remarks resolve the rejections asserted in the January 7, 2005, Office Action and render the application in a condition for allowance. Applicant requests early and favorable action. The Examiner is invited to call the undersigned attorney if that would be helpful in resolving any matter which might remain.

Respectfully submitted,

  
Peter N. Jansson  
Registration No. 26,185

Jansson, Shupe & Munger, Ltd.  
245 Main Street  
Racine, WI 53403-1034  
Telephone: 262/632-6900  
Fax: 262/632-2257  
Attorney Docket No. EMP-134US

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May 5/9/05

Christine M. Wipper,

Name

Christine M. Wipper 5/9/05

Signature

Date

AMENDMENT TO THE DRAWINGS

Please amend FIGURE 1 as follows:

Delete both references to item number 70

Delete both references to item number 60

Delete the line extending from item number 23.

Add the line extending from number 23 as shown in the redline copy.

Please amend FIGURE 2 as follows:

Delete both references to item number 40.

Add a bubble as shown in the redline copy between item number 41 and item number 42.

Please amend FIGURE 4 as follows:

Delete item number 60.

Please amend FIGURE 5 as follows:

Delete item number 60.

Please amend FIGURE 6 as follows:

Delete item number 60.

Please amend FIGURE 1 as follows:

Delete item number 60.



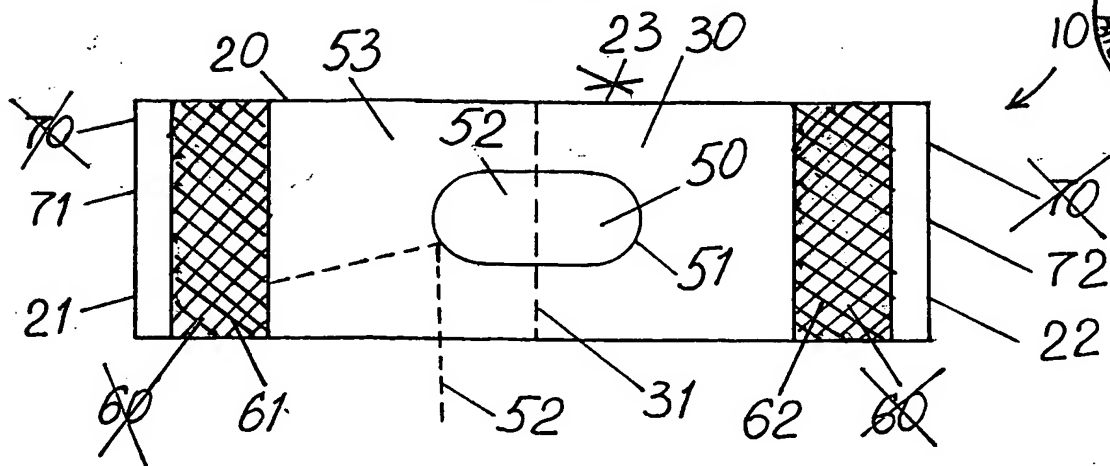


FIG. 1

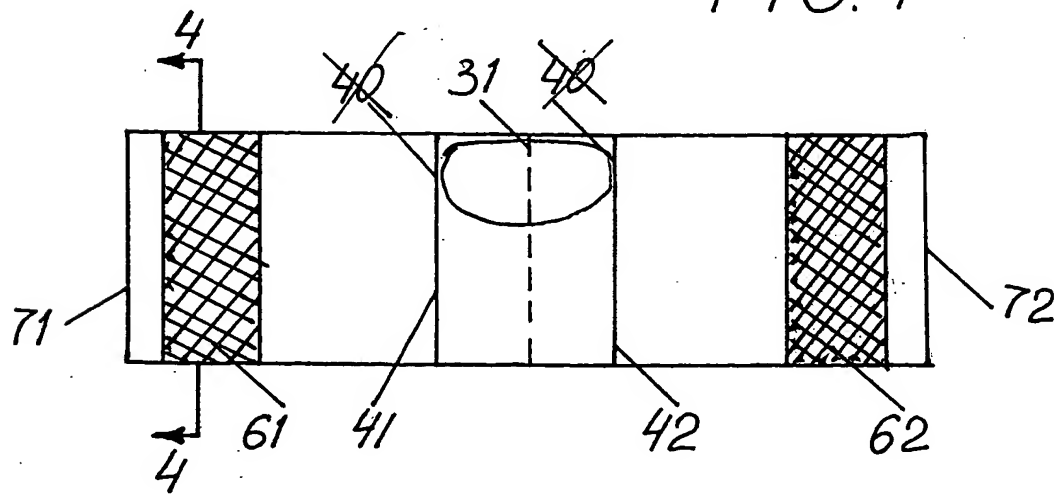


FIG. 2

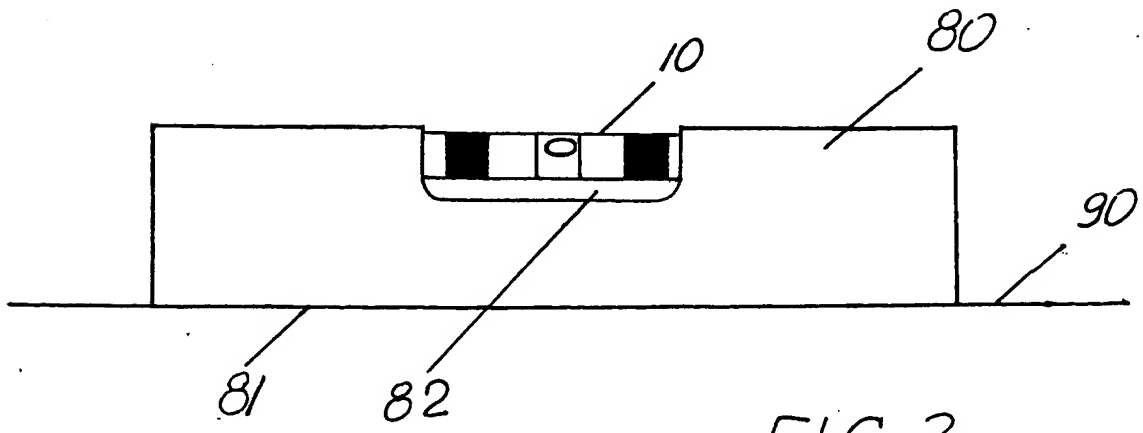


FIG. 3

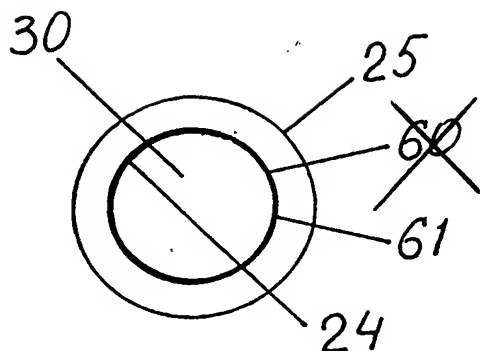


FIG. 4

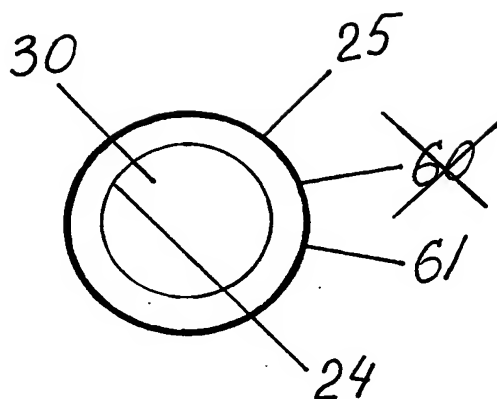


FIG. 5

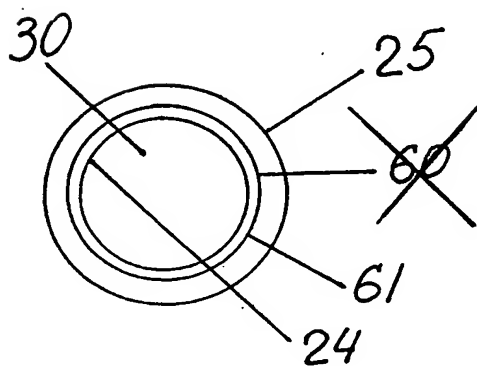


FIG. 6

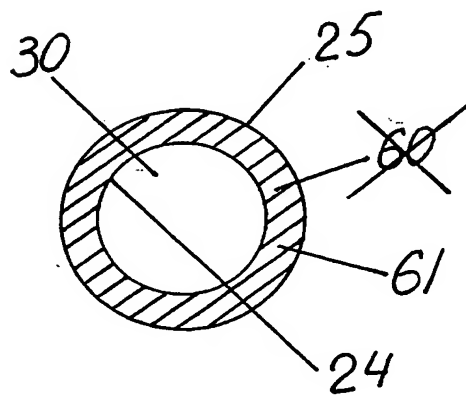


FIG. 7